

REMARKS

Claims 1-30 are pending. Claims 1, 10, 12-13, 25, and 29 stand objected to as having informalities. Claims 1-12 and 16-22 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the admitted prior art. Claims 1-2 and 7-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,047,300 to Walfish et al. Claims 23-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,875,443 to Nielsen.

Reconsideration is requested. No new matter is added. The specification is amended. Claims 1, 11, 23, 26, and 29 are amended. Claims 31-32 are added. The rejections are traversed. Claims 1-32 remain in the case for consideration.

OBJECTION OF CLAIMS AS HAVING INFORMALITIES

The Examiner objected to claim 1 as having the term “comprising” instead of the term “comprising the steps of” because the claim specifies a method. But nowhere does the MPEP require that a method claim describe the method as comprising steps. As described in MPEP § 2111.03, the transitional phrases are described as “comprising,” “consisting essentially of,” and “consisting of.” MPEP § 2111.03 does not require that method claims be described as “comprising the steps of.” In fact, MPEP § 2111.03 specifically says that “[t]he transitional term ‘comprising,’ which is synonymous with ‘including,’ ‘containing,’ or ‘characterized by,’ is inclusive or open-ended and does not exclude additional, unrecited elements *or method steps*” (emphasis added). In other words, a method claim does not have to say that the method comprises particular steps. Accordingly, claim 1 does not require amendment to specifically state that the method “comprises the steps of.”

The Examiner objected to claims 10 and 12 because he thought the indefinite article “an” should be replaced with “the” with reference to the “alternate correctly spelled word,” and that the definite article “the” should be replaced with “an alternate” in line 3 of the claims. To begin with, there are three “the” words in line 3 of the claims, and the Examiner has been unclear as to which of these words he thought should be replaced. But ignoring this problem, the suggested amendments are inappropriate for two reasons. First, such an amendment would create an antecedent basis problem with respect to the phrase “alternate correctly spelled word,” which is used for the first time at line 2 of claims 10 and 12.

Second, the amendment the Examiner appears to be proposing would not describe the invention. Based on a reading of the Examiner’s objection, it appears the Examiner is suggesting amending claims 10 and 12 to describe replacing the “correctly spelled word”

not described
in C1

with an "alternate correctly spelled word." [But the "correctly spelled word" is the corrected spelling of the word as received from the user, as described in claim 1.] The "alternate correctly spelled word" is the corrected spelling currently associated with the misspelled word in the static update list. While the "alternate correctly spelled word" is a valid word, does *not* represent the word that the user wants to be substituted automatically for the misspelled word. In other words, the user is replacing one correct spelling (the "alternate correctly spelled word") with another correct spelling (the "correctly spelled word"). Claims 10 and 12 correctly describe the invention, and therefore no amendment is necessary.

The Examiner's objection to claim 13 is based on the same misinterpretation of the invention. As pointed out above, the invention replaces one correctly spelled word (the "alternate correctly spelled word") with another word (the "correctly spelled word") the user prefers to use as a correction to the misspelled word. Thus, the word "alternate" belongs in claim 13, to identify the other correct spelling that the user is replacing.

It might be helpful to use a concrete example to explain the argument: one described in the specification at FIG. 7 and the accompanying description at page 6, lines 10-19. In the indicated portion of the specification, the misspelled word is "theri," and the spelling currently in the static list is "their." Note that "their" is a valid word. But assume that the user prefers that "there" be the automatic correction of "theri": that is, whenever the user types "theri" by mistake, the user wants the word "there" put in the place of "theri" automatically. Thus, "their" is the alternate correctly spelled word, being replaced by the correctly spelled word "there." This is what is claimed in claims 10, 12, and 13.

The Examiner objected to claim 25 as failing to further limit the subject matter of the previous claim. The Examiner argues that a counter inherently includes an incrementer. This argument is false. A "counter" is a number stored somewhere (e.g., in memory). Numbers do not change their values on their own: something else has to act on the number to change its value. This is precisely what an incrementer does.

The prior art cited by the Examiner is pertinent to this point. In Nielsen, at column 4, lines 20-31. Nielsen describes the third database as storing "words . . . that have been requested by users . . . , together with the number [i.e., a counter] of times that each word in this database has been requested. . . . If [the word requested to be added] already exists in this database, then the number of request instances for the word is increased [i.e., incremented] by one." Thus, claim 25 further limits the subject matter of the claim, and requires neither cancellation nor amendment.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102(a)

The Examiner rejected claim 1 as being disclosed as admitted prior art, and rejected claim 11 as being a program that performs the method of claim 1, and therefore rejected using the same rationale. The Applicant agrees that the manual update of the static update list was known before the date of invention. But the update of the static update list *by the computer* is something that was not known before the date of invention. Claims 1 and 11 have been amended to describe the method and software as being operable by a computer, with the updating being done by the computer, as opposed to a manual update. Accordingly, claims 1-22 and 31-32 should now be allowable over the admitted prior art.

The Examiner rejected claims 5 and 22 as being disclosed as admitted prior art. The Examiner argued that the misspelled word and the correctly spelled word are “inherently ‘stored’ in a ‘dynamic update list’ because anytime a computer user enters keystrokes, that data is temporarily stored in the computer” (page 6 of the Office Action dated December 15, 2004). While the Examiner might be correct that the computer temporarily stores keystrokes, that does not mean that the computer can determine any inherent significance to the keystrokes, and the computer is certainly not creating a dynamic update list. The dynamic update list is clearly described with reference to FIGs. 8 and 9A-9B, and is more than just a temporary collection of keystrokes. And regardless of whether or not the computer is temporarily storing the words, the computer is not storing a measure of how useful it would be to add the misspelled word and the correctly spelled word to the static update list, as described in new claims 31-32.

In addition, even if the temporary storage of keystrokes in the computer qualified as a dynamic update list (a position the Applicant disputes), such storage of keystrokes is lost the moment the user powers the computer down. But the dynamic update list, like the static update list, can be maintained beyond the shutdown of the computer.

Finally, for the Examiner to be correct that the dynamic update list is admitted prior art, the Examiner would have to show the disclosure of the dynamic update list as prior art. In fact, the background section of the patent application (upon which the Examiner is relying in rejecting the claims) makes no mention of the dynamic update list, and explains the problem *for which the dynamic update list is a solution*. The Examiner cannot assert that a feature of the claims is disclosed as admitted prior art when, in fact, the feature is not admitted to be prior art. The first mention of the dynamic update list is in the summary of the invention, at page 3, line 3, which is decidedly *not* admitted prior art. Accordingly, claims 5-6, 22, and 31-32 are not anticipated by the Applicant’s admitted prior art.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102(e)

Referring to claim 2, the invention is directed toward a method for updating a static update list. The method of claim 2 depends from claim 1, wherein automatically updating the static update list includes tracking a measure of how useful it would be to add the misspelled word and the correctly spelled word to the static update list. Claim 19 is a Beauregard claim paralleling claim 2.

In contrast, Walfish teaches a system and method for automatically correcting words. Walfish discloses the basic approach used by Microsoft Word in its AutoCorrect feature. Pertinent to claims 2 and 19, the Examiner cites to column 3, lines 48-62, wherein Walfish discusses exceptions words: words that the user has defined to not be subject to replacement using AutoCorrect.

The Examiner says that because the exceptions list prevents a word pair from being added to the AutoCorrect list, Walfish discloses the tracking measure of claims 2 and 19. The Applicant disagrees. Had claims 2 and 19 described the tracking measure as indicating how useful it would be to keep a misspelled word and a correctly spelled word pair *out* of the static update list, Walfish might disclose the feature. But instead, Walfish provides a list of words that are not to be corrected. Because Walfish lists only words that are not corrected despite being “misspelled,” Walfish is not including a tracking measure for the *pair of words* (the misspelled word and the correctly spelled word). As claims 2 and 19 are specific that the tracking measure applies to the pair of words, Walfish does not disclose this feature, and cannot anticipate claims 2 and 19.

In addition, as claims 1 and 11 have been amended to describe the method and software as being operable by a computer (that is, not by a user), a manual change as taught by Walfish does not anticipate the invention. But Walfish makes clear that the exception words are identified by the user explicitly saying, “Don’t correct this word.” Walfish describes two ways in which the list of exception words could be generated: by the user editing the list of exception words, and by the user rejecting a replacement word. Since both of these approaches require user involvement, Walfish cannot anticipate the automatic determination of exception words. In contrast, claims 2 and 19 can be implemented without the user having to make any overt indication that the misspelled word and the correctly spelled word be tracked.

Accordingly, Walfish does not teach or suggest all of the features of claims 2 and 19, and accordingly, claims 1-22 and 31-32 are allowable under 35 U.S.C. § 102(e) over Walfish.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102(b)

Referring to claim 23, the invention is directed toward an apparatus for correcting misspelled words in a document, comprising: a computer and document editor program; a spell-checking program running on the computer in conjunction with the document editor program; a static update list of pairs of first misspelled and known correctly spelled words, the static update list stored on the computer; a dynamic update list of pairs of second misspelled words and possibly correctly spelled words, the dynamic update list stored on the computer; and a measure for each pair in the dynamic update list indicating whether it is worth adding at least one of the second misspelled words and at least one of the possibly correctly spelled words to the static update list.

Referring to claim 26, the invention is directed toward an apparatus for correcting misspelled words in a document. The apparatus of claim 26 depends from claim 23, and further comprises a first update unit for automatically updating the static update list from the dynamic update list.

Referring to claim 28, the invention is directed toward a data structure in a computer memory device for storing a dynamic update list of correctly spelled words as replacements for misspelled words, the data structure comprising: a series of entries, wherein each entry includes: a misspelled word; a correctly spelled word; and a measure indicating whether it is worth adding the misspelled word and the correctly spelled word to a static update list.

In contrast, Nielsen teaches an Internet-based dictionary system. Users can send Internet requests to add new words to the dictionary of approved words. The user is notified if the word is misspelled, and the data is periodically updated based on the requests words. The updated dictionary is periodically released to users as an upgrade to the main dictionary, and users are compensated for the words they contribute to the approved dictionary.

First, while the Examiner rejected claims 23-30 under 35 U.S.C. § 102(b) as being anticipated by Nielsen, the issue date of Nielsen was October 19, 1999. As the filing date of the patent application was March 28, 2000, the patent application was filed less than one year after the issue date of Nielsen. Under MPEP § 706.02(a), Nielsen is not available as prior art under 35 U.S.C. § 102(b), but rather as 35 U.S.C. § 102(e).

Claim 23, as amended, is not anticipated by Nielsen. Claim 23 calls for the static update list and the dynamic update list to be stored on the same computer as that with the document editor program. Nielsen discloses at most two databases being stored on the computer with the user: the main dictionary and the local custom dictionary. Note that

neither of these databases is an update list (either static or dynamic), which has to have pairs of misspelled words and correctly spelled words: the databases stored on the computer are simply lists of properly spelled words. The other databases disclosed by Nielsen are stored with the vendor. These include the vendor's current main dictionary, the second database (which stores pairs of known misspelled words along with suggested correct spellings), and the third database (which stores words users have requested be added to the database of approved words, along with the number of request instances for each proposed word). As these databases are stored with the vendor (and not with the user and his document editor program), Nielsen cannot anticipate claim 23 as amended.

It is worth noting that the amendments to claim 23 do not narrow the claim: they merely make explicit concepts that were already implicit. Nielsen teaches a system, comprising multiple computers linked by a network. In contrast, claim 23 claims an *apparatus*. This, claim 23 already implicitly included the static update list and the dynamic update list as part of the computer, and the amendments only clarify this fact; the amendments do not narrow the claim.

In addition, while Nielsen does disclose the third database counting the number of request instances, this database does *not* contain pairs of misspelled words and suggested correct spellings (as claimed for the dynamic update list). The third database stores *only* words that are not recognized by the spelling checker, but which users believe are correctly spelled. While Nielsen discloses separate databases that include features similar to the dynamic update list, Nielsen does not combine the features of the dynamic update list into a single database. Under MPEP § 2131, "elements must be arranged as required by the claim" (citing to *In re Bond*). Because Nielsen does not arrange the features as described in claims 23 and 28, Nielsen cannot anticipate claims 23 and 28.

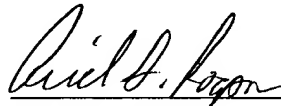
Claim 26 has been amended to describe the first update unit as automatically updating the static update list from the dynamic update list. Nielsen describes the process of updating the main dictionary as a manual process, "performed by a person with appropriate language skills" (column 4, lines 33-34). As Nielsen does the update of the main dictionary manually, Nielsen cannot teach or suggest performing an automatic update of the static update list. In fact, Nielsen teaches away from the concept of automatic update. At column 3, lines 15-17, Nielsen says that "[t]his selection process [selecting word spellings to be added to the dictionary] *cannot be completely automated*, and requires the efforts of personnel who are lexicographically skilled." As the invention describes a way to update the static update list without any manual effort, Nielsen's teachings are contrary to the invention. Accordingly,

Nielsen does not teach or suggest all of the features of claims 23, 26, and 28, and accordingly, claims 23-30 are allowable under 35 U.S.C. § 102(b)/(e) over Nielsen.

For the foregoing reasons, reconsideration and allowance of claims 1-30 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

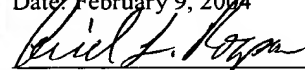
MARGER JOHNSON & McCOLLOM, P.C.



Ariel S. Rogson
Reg. No. 43,054

MARGER JOHNSON & McCOLLOM, P.C.
1030 SW Morrison Street
Portland, OR 97205
503-222-3613
Customer No. 20575

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Ariel S. Rogson